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EXAMINER

HARRELL, ROBERT B

ART UNIT PAPER NUMBER

2142

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/050,328

Applicant(s)

KITA ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20021021 ✓
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached Office Action.

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1. Claims 1-32 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The language of the Abstract should be clear and concise, with the form and legal phraseology often used in patent claims, such as "means" and "said," avoided per MPEP 608.01(b).
4. There is no "Summary of the Invention". The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if

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the required "Sequence Listing" is not submitted as an electronic document on compact disc).

5. The drawings are objected to since it cannot be clearly ascertained if sheet 19/19 belongs to the drawings as it is not a numbered figure.

6. Page 1 (last line) and Page 2 (line 13+) make reference to figures 1 and 2 as if they were prior art and yet such figures are not so labeled as "Prior Art". Thus for this reason also, the drawings are objected to as well as the specification for being inconsistent with the drawings.

7. The specification is further objected on grammatical grounds as being replete with grammatical and idiomatic errors to numerous to mention specifically. The specification should be revised carefully. For an example, page 22 (third to the last line "ha" [?has?] or [?have?]) is in error. This is only one example of numerous cases of errors.

8. The claims are drafted in "means-plus-function" format, and yet the specification also uses "means" (e.g., page 4 (third to the last line)) which is in a section titled "Disclosure of Invention". This causes problems under 35 U.S.C. 112, second paragraph, to be indicated below and thus such legal phraseology cannot be used in the textual portion of the specification or drawings.

9. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, and clarity of meaning in the Specification, Drawings, and specifically claims. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

10. Because the numerous errors will result in numerous amendments to the specification, a New Specification is required. The applicant is reminded that a declaration to the effect that there is NO NEW MATTER be also executed and provided.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

12. Claims 1-32 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

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- a) "the fact"--claim 1 (line 8);
- b) "the need"—claim 10 (line 4), claim 19 (line 6), claim 28 (line 10).

13. As to 12 (a and b) above, these are but a few examples of numerous cases where clear antecedent bases are lacking and not an exhausting recital. Any other term(s) or phrase(s) overlooked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent bases also is (are) indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction(s) of a term, or changes in tense, results in a lack of clear antecedent bases for term(s) or phrase(s), which relied upon the introduced term. Failure to correct all existing cases where clear antecedent bases are lacking can be viewed as non-responsive.

14. The claims are replete with grammatical and idiomatic errors to numerous to mention specifically making a clear understanding of any one claim near impossible.

15. The specification uses "means-plus-function" format consistent with the claims. Thus *the* corresponding structure in the specification cannot be clearly ascertained because of this indefinite loop (see "**Disclosure** of Invention").

16. In view of all these errors, and to the best examiner can understand the invention described and claimed, the following best rejection is forwarded and based upon the substantial evidence of record in the spirit of compact prosecution in light of the current drafting of the specification and claims.

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

***A person shall be entitled to a patent unless -***

***(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;***

18. Claims 1-32 are rejected under 35 U.S.C. 102 (e) as being anticipated by Berstis et al. (US 6,615,239 B1).

19. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/>

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**portal/pair))),** this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is hereby cited* and relied upon in this action as part of the substantial evidence of record.

20. Since the Abstract and specification each contain "means", examiner is unable to ascertain the corresponding structure in the specification since the specification itself describes the invention in terms of "means" with generalized functional blocks. Thus the following cited elements within the reference are the same corresponding structure disclosed and/or are equivalent elements by their functionality with overall structures provided in more detail by the reference. In general, Berstis taught of loading a PCMCIA (figure 2) with network settings wirelessly downloaded from a host computer for use in a notebook based conference system with an overhead projector (figure 1). In light of the corresponding structure provided, in part, by applicant's figure 3 and figure 5 with other corresponding structures, including these, also addressed below, examiner now forwards the following grounds of rejection under 35 U.S.C. 102(e) as best as the claims can be understood.

21. Per claim 1, Berstis taught ***a card*** (e.g., see figure 2 (PC CARD SLOT), figure 3, Abstract, col. 3 (lines 38-39), and col. 4 (lines 16-18)) ***type network*** (e.g., see figure 1 (15) and col. 3 (lines 47-54) in that the Infa Red (IR) system becomes a local area network among the terminals on the table of figure 1) ***interface which can be attached to an information terminal device*** (e.g., see figure 1 (16) as better shown in figure 2), ***comprising:***

***a) connecting means*** (e.g., see figure 3 (22 and 24) per col. 3 (line 66) to col. 4 (line 18)) ***for connecting said information terminal device to a local area network*** (e.g., the local area network has been defined as that having been set up by the IR communication link among the notebook terminals); ***and***

***b) setting means*** (e.g., see col. 4 (lines 7-18)) ***for requesting*** (e.g., see col. 9 (lines 24-33) in that the software/driver/configuration-files can be requested via a download from the network) ***a host*** (e.g., see figure 1 (14)) ***of said local area network*** (e.g., the IR communication link among the notebook terminals as shown in figure 1 was a local area network) ***to transmit setting information*** (e.g., see col. 9 (lines 24-40)) ***necessary for executing a network setting*** (e.g., see col. 3 (lines 58-65)) ***to connect said information terminal device to said local area network*** (e.g., see col. 3 (line 66) to col. 4 (line 18)) ***based on the fact that said card type network interface can be attached*** (e.g., see figure 2 (the PCMCIA card)) ***to said information terminal device*** (e.g., see figure 1 (16) and figure 2) ***and executing said network setting by using said setting information transmitted from said host*** (e.g., see col. 5 (line 35) to col. 6 (line 24)).

22. Per claim 2, in col. 4 (lines 4-18) for example, a notebook could either be the presentation computer (host computer) or a receiving computer and thus a determination was made as to the mode of the computer. Once the mode was selected, downloading the required operating software and configuration files from the host, via the network, was covered in col. 9 (lines 24-41). This includes all software to allow the receiving

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computer to be configured as a receiving computer including network interface drivers and network settings.

23. Per claim 3, see Abstract and col. 9 (lines 24-26).

24. Per claim 4, see col. 8 (lines 3-26) and col. 9 (line 31 "hard drive") while viewing figure 3 in that the Operating System and presentation software combined was an automatic activating application software called upon by the boot process that normally reads the PCMCIA card type (PCMCIA were hard-drive communications combatable). PCMCIA stands for Personal Computer Memory Card International Association.

25. Per claims 5 and 6, since all notebooks of figure 1 can be either the presentation computer (i.e., a host) or the receiving computer, such claimed negotiation was covered in col. 4 (lines 4-18) in that any one of the computers could first be the presentation computer, while the others were the receiving computer, and then toggle such functionality (the applicant's claim 6) accordingly during presentation per col. 4 (lines 20-21 "or portions thereof") implies the clients can partake in the presentation and col. 2 (lines 37-42) implies that a receiving computer can correct and share the presentation and/or notes to all other participants (this required the client to become the presenter).

26. Per claim 7, see col. 4 (lines 16-18) for the claimed processing means and col. 8 (lines 53) to col. 9 (line 4) for polling.

27. Per claim 8, see Abstract and col. 9 (line 26 "software") in that anything transmitted via IR from the presentation computer must have been stored and sent via the PCMCIA card.

28. Per claim 9, see col. 8 (lines 3-26) and col. 9 (line 31 "hard drive") while viewing figure 3 in that the Operating System and presentation software combined was an automatic activating application software called upon by the boot process that normally reads the PCMCIA card type (PCMCIA were hard-drive communications combatable). PCMCIA stands for Personal Computer Memory Card International Association.

and 29. Per claims 10-32, these claims do not substantially teach or define above the correspondingly rejected claims and are thus also rejected under 35 U.S.C. 102(e) for the same reasons given for the above mentioned claims 1-9. However, in addition to the above, and specifically, per claims such as claim 10, claim 19, and claim 28, corresponding dependent claims thereof, it has been shown above that the applied reference system of figure 1 is for a conference in an IR (wireless via Infa Red communication link per col. 9 (line 18)) networked system in which col. 9 (lines 24-40) taught that all software (including network interface card drivers, presentation software, reception software, and configuration normal to network settings) could be download (col. 9 (line 33)) from the network from another computer (i.e., computer host 14 via wireless network 15 of figure 1) for execution at anyone, or all, of the receiving terminal computers. The presentation and receiving computers also could obtained all software, drivers, and network setting, from the Internet per col. 9 (line 9 "Internet") in view of col.

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9 (line 33 "download"). Also the projector and computer 14 of figure 1 in the applied reference was the image display presentation device according to a need such as a conference need. Since col. 3 (lines 38-40) stated that the IR port components may be implemented in a card bus device, such as a PCMCIA card, and per figure 3, placing the whole of the IR system (including software, drivers, and network settings to configure the card) was thus clearly anticipated by the applied reference.

30. A shortened statutory period for response to this action is set to expire **3 (three) months** and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become **abandoned** (see MPEP 710.02, 710.02(b)).

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (703) 305-9692. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (703) 308-9705. The fax phone number for all papers is (703) 872-9306.

33. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142